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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,622

02/07/2002

Lieping Chen

07039-331001

3225

26191 7590 12/20/2006

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EXAMINER

OUSPENSKI, ILIA I

ART UNIT

PAPER NUMBER

1644

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/20/2006

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/072,622

Applicant(s)

CHEN ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3 - 8 and 12 - 26 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 12 - 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 7 and 24 - 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

1. Applicant's amendment/remarks, filed on 10/09/2006, are acknowledged.

**Claims 1, 3 – 8, and 12 – 26 are pending.**

Claims 1 and 26 have been amended.

Claims 8 and 12 – 23 have been withdrawn from consideration by the Examiner as being drawn to nonelected inventions (see Office Action mailed 05/03/2005).

***Claims 1, 3 – 7, and 24 – 26 are under consideration in the instant application.***

2. This Office Action will be in response to applicant's amendment and arguments, filed 10/09/2006.

The rejections of record can be found in the previous Office Action, mailed 07/07/2006.

The text of those sections of Title 35 USC not included in this Action can be found in a prior Office Action.

3. ***The rejections of record have been withdrawn in view of Applicant's amendment and arguments, except as set forth herein.***

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4. Claims 1, 3 – 7, and 24 – 26 stand rejected under **35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite in the recitation of "B7-H2" because its identity is unclear.

Applicant's arguments have been fully considered but have not been found convincing.

Applicant argues that those skilled in the art would understand what is claimed when the claim is read in light of the specification, in particular at page 23, which discloses that the human B7-H2 polypeptide used in the Examples is that whose sequence is depicted in the reference of Wang et al. (of record).

This is not found persuasive, because, since the cited reference pertains to an example, it does not appear to limit the claimed polypeptide to the sequence disclosed by Wang et al. Furthermore, reliance on the reference for recitation of essential material raises the issue of improper incorporation by reference.

Additionally, when analyzed in light of the teachings of the prior art, the recitation of "B7-H2" is indefinite, because others in the art use the same name for designation of a different polypeptide, as addressed in the prior Office Action.

Therefore, the rejection of record is maintained for the reasons of record, as it applies to the amended claims. The rejection of record is incorporated by reference herein, as if reiterated in full.

Art Unit: 1644

5. Claim 26 stands rejected under **35 U.S.C. 112, first paragraph**, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *This is a New Matter rejection.*

The recitation of a fusion polypeptide comprising ICOS and an "immunoglobulin CH2-CH3 sequence" represents a departure from the specification and the claims as originally filed.

Applicant's arguments have been fully considered but have not been found convincing.

Applicant points to the specification at page 18, lines 18 – 20, for support of the above recitation. It is acknowledged that the specification discloses that that an ICOSlg polypeptide can be produced by linking sequences of ICOS and "the CH2-CH3 portion of human IgG1," this passage does not provide sufficient support under 35 USC 112, first paragraph, for the generic recitation of "immunoglobulin CH2-CH3 sequence."

Therefore, the rejection of record is maintained for the reasons of record, as it applies to the amended claims. The rejection of record is incorporated by reference herein, as if reiterated in full.

**6. Conclusion: no claim is allowed.**

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

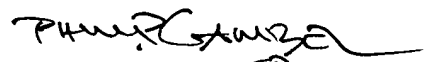
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

Art Unit 1644

December 12, 2006

  
PHILLIP CAMBEL, PH.D. JD  
PRIMARY EXAMINER  
TC 1600  
12/12/2006